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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,405	11/14/2001	Toshiaki Miyagi	MA-509-US	7051

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EXAMINER
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OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/987,405

Applicant(s)

MIYAGI, TOSHIAKI

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040420.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 4, 8, 10, 12, 15, and 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
3. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.
4. The independent claims disclose a system/method for providing map information to a user; wherein the user is charged for information that was not been previously registered (paid for) by an information provider (advertiser). However, the format of the independent claims are hard to follow and understand (second step previous to first step, etc.) and can easily be misconstrued as selling a "destination" to a user (tickets, etc.), instead of map information directed towards a destination.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the

prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Stuntebeck et al. (US 6,065,016) in view of Dunworth et al. (US 5930474).**

7. As per **independent Claims 1, 4, 8, 10, 12, 15, and 17-22**, Stuntebeck discloses a map information providing device (system, method program) for providing map information of a destination a user wants (Universal directory including map information, abstract, C2 L30-36), in response to a request from a user terminal device through a network, comprising: means for registering a destination which a map information provider originally selects (UDS Database); and means for checking whether the requested destination is the initial information or the supplemental/additional information when the map information of the destination is requested by the user terminal device, as the result, when the destination proves to be the initial information, providing the map information free of charge (flat rate no charge for separate search, C6), while when the destination proves to be the supplemental/additional information (C6, two-tiered price structure), notifying the user terminal device of the effect that the second destination is with a charge, so to confirm a user's will to pay for the charge, and when acceptance of the payment is confirmed by the user terminal device, performing billing processing and providing the map information (C6, upon confirmation providing supplemental information), while when refusal of the payment is confirmed by the user terminal device, finishing a connection.

8. Stuntebeck fails to disclose wherein the first initial or first set of information is paid for by the advertiser, or dealer who is under contract with a map information provider to be published on a map as map information.
9. However, Dunworth discloses wherein the advertiser/information provider pays for the directory service (yellow pages / map information) to be provided to the user (Fig.17, Ext. Price; C24 L29-67, C25 L1-20, Yellow Pages Database, price the publisher charges the advertiser), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the provider paid information as a level or set of information requested by the customer.
10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the first initial or a set of information is paid for by the dealer who is under contract with a map information provider to be published on a map as map information (provider paid information), as disclosed by Dunworth in the system disclosed by Stuntebeck, for the advantage of providing a map information providing system/method with the ability to increase customer service by subsidizing the cost for information, and increasing business effectiveness by creating multiple sources of income (information providers / information users).
11. As per Claim 2, Stuntebeck and Dunworth disclose means for checking whether the requested destination is the first destination or the second destination when the map information of a destination is requested by the user terminal device (Stuntebeck: Fig.2, abstract, C2 L30-36).

12. As per Claims 3, 6, 9, 11, 13, and 16, Stuntebeck and Dunworth disclose wherein said map information providing means creates and provides the map information with a mark attached to the corresponding destination when providing the map information (Dunworth: Graphically display maps with Points of Interest (POIs), C11-C12).
13. As per Claim 5, Stuntebeck and Dunworth disclose wherein said map information providing means further includes a function of creating and providing the map information including all the destinations on the same map when there is a request for two or more destination requiring the map information (Dunworth: Graphically display maps with Points of Interest (POIs), C11-C12).
14. As per Claims 7 and 14, Stuntebeck and Dunworth disclose wherein said map information providing means further includes a function of creating and providing the map information including all the destinations on the same map when there is a request for two or more destinations requiring the map information, and creates and provides the map information with a mark attached to the corresponding destination when providing the map information (Dunworth: Graphically display maps with Points of Interest (POIs), C11-C12).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
16. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

**Switchboard, Inc. Teams With Be Free, Inc. to Launch Performance-Based Affiliate Marketing Program." Business Wire, November 8, 2000.**

Switchboard discloses an online system for searching and displaying directory and map information to users.

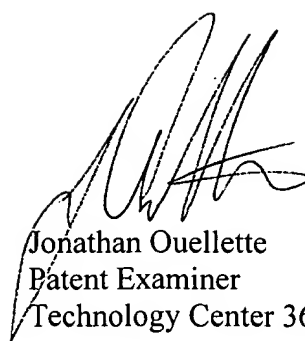
17. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

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March 2, 2006

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A handwritten signature in black ink, appearing to read 'Jonathan Ouellette', is written over the printed name and title.

Jonathan Ouellette  
Patent Examiner  
Technology Center 3600